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| 09/441,892      | 11/17/1999  | John S. Hendricks    | 026880.00011        | 5151             |

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| EXAMINER |
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LANEAU, RONALD

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| ART UNIT | PAPER NUMBER |
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3714

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/441,892

Applicant(s)

HENDRICKS ET AL.

Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19,22-33,42-74 and 89-97 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19,22-33,42-74 and 89-97 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>09282006</u> . | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. The amendment filed on 09/05/06 has been entered. Claims 20 and 21 are canceled, claim 97 is added and claims 1-19, 22-33, 42-74 and 89-97 are now pending.

***Information Disclosure Statement***

2. Applicant should note that the large number of references in the attached IDS have been considered by the examiner in the same manner as other documents in Office search files are considered by the examiner while conducting a search of the prior art in a proper field of search. See MPEP 609.05(b). Applicant is requested to point out any particular references in the IDS which they believe may be of particular relevance to the instant claimed invention in response to this office action.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-4, 6-12, 13-19, 22, 24-33, 42-45, 48-62, 64-74, 86-89, 91-93, and 95-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton (US 4,985,697) in view of Morales (US 5,663,757) and further in view of Hoffman (US 2005/0144133 A1).

As per claims 1-3, 9, 13, 14, 19, 25-27, 29-33, 42-45, 50, 54, 55, 60, 66-68, 70-74, 89, 91 and 97, Boulton discloses a method for providing electronic commerce using an electronic book, comprising: displaying an electronic book (fig. 1, 156); receiving a user's selection of the product or service (col. 4, lines 6-8). Boulton does not disclose a request to purchase but Morales discloses a request to purchase the selected product or service (col. 4, lines 15-26); and performing a transaction to execute the purchase request (see abstract). Neither Boulton nor Morales discloses presenting an identification of a product or service but Hoffman discloses presenting associated with the electronic book an identification of a product or service (pages 12-14, [0184], lines 10-15); receiving from the user an offered price for the product or service, determining whether to accept the offered price; and selectively transmitting an indication of an acceptance of the offered price based upon determining, wherein the determining step includes determining whether to accept the offered price based on the amount of the offered price (see claims 38-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the request to purchase a product or service order as taught by Morales into the system of Boulton because it would provide improved comprehensive interactive systems having instantaneous online nationwide communication capabilities. And it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to display the electronic book as taught by Hoffman into the combined systems of Boulton and Morales because it would provide an automated electronic intelligent agent for electronic data search and retrieval that is customized to the user's requests.

As per claim 4, 6, 7, 47, 48, 92 and 96 Morales discloses a method of electronic payment for the product or service using a credit card or bank transaction, an apparatus wherein the module includes establishing an electronic communication with a web site for executing the purchase request as claimed.

It would have been obvious to one of ordinary skill in the art to utilize an electronic payment as taught by Morales into the systems of Boulton and Hoffman for the same reasons given in claim 1.

As per claims 8 and 49, Boulton teaches a method wherein the presenting step includes displaying an icon identifying the product or service and the receiving step includes receiving selection of the icon by the user as claimed (fig. 1, 156).

As per claims 10-12, and 51-53, Morales teach displaying an advertisement relating to the product (see abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the advertisement display as taught by Morales into the systems of Boulton and Hoffman because it would allow a user to click and display more information about the item being advertised on the display screen.

As per claims 15-18 and 56-59, Boulton teach a recording module for recording statistical information concerning purchases of the product or service (col. 11, lines 47-54).

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As per claims 22, 23, 63 and 64, neither Boulton nor Morales discloses an encryption module for encrypting the transaction for purchase execution of the purchase request, an encryption module including a module for using a digital signature but the examiner takes the Official notice that an encryption and a digital signature in electronic commerce are well known in the art because it would insure the security of the information being electronically transmitted over a network. And confirm at the other end that the right person has signed the document to authorize the transaction.

As per claims 24 and 65, neither Boulton nor Morales discloses displaying an hypertext link identifying the product or service and the receiving step includes receiving selection of the hypertext link as claimed but Hoffman discloses web links that are capable of identifying product or service as claimed (page 14, [0198], lines 12-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a display including web links for the same reasons given in claim 1.

As per claims 28 and 69, Boulton discloses a method wherein the providing step includes presenting an image (see fig. 8).

As per claim 40, the examiner interprets the claimed sample section to be a small window like a pop-up ad in a section of the display screen. Boulton teaches displaying a product on the screen, which can be considered, to be a sample section capable of presenting a sample of the product as claimed.

As per claims 61, 62, 93, and 95, see rejection of claim 1. Neither Boulton nor Morales discloses prices for the products or service but Hoffman discloses the steps of determining whether to accept the offered price (see claims 38-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the price approval as taught by Hoffman into the systems of Boulton and Morales for the same reasons given in claim 1.

6. Claims 5, 38, 46, 79, 90 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boulton (US 4,985,697) in view of Morales (US 5,663,757) further in view of Hoffman (US 2005/0144133 A1) and further further in view of Pocock et al (US 5,014,125).

As per claims 5, 38, 46, 79, 90 and 94, neither Boulton nor Morales discloses a digital coupon for use in purchasing the product or service but Pocock discloses the use of coupon for customer's discounts on a product or service as claimed (col. 17, lines 17-28). Pocock's coupon is considered to be digital since customer has to download said coupon in order to print it.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the request to purchase a product or service order as taught by Morales into the system of Boulton because it would provide improved comprehensive interactive systems having instantaneous online nationwide communication capabilities. And it would have been obvious to one of ordinary skill in the art at the time the invention was made to display the electronic book as taught by Hoffman into the combined systems of Boulton and Morales because it would provide an automated electronic intelligent agent for electronic data search and retrieval that is customized to the user's requests. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a coupon as taught by Pocock into the combined systems of Boulton, Morales and Hoffman because it would give more incentives to an on-line shopper to buy a particular product at discounted price.

***Response to Arguments***

7. Applicant's arguments filed 9/5/06 have been fully considered but they are not persuasive.

Applicant argues that none of Boulton, Morales, and Hoffman disclose or suggest at least the added limitations of "receiving from the user an offered price for the product or service, determining whether to accept the offered price; and selectively transmitting an indication ...". In response to Applicant's arguments, Hoffman does disclose such limitations (see rejection above). Applicant further argues that Hoffman is not qualified as prior art reference unless the portion cited by the Examiner is contained in the unpublished parent application. In response to Applicant's arguments, even though the Examiner established an August, 1997 priority date for this application in the Office action mailed on August 24, 2004, that does not necessarily mean that all the limitations meet the standard. Applicant is required to show the argued portion of the claimed invention rejected by Hoffman deserves priority of US patent application No. 08/906,469. Applicant is required to show that these limitations are disclosed in such application by providing the exact column and lines where these limitations can be found. Furthermore, Applicant argues that none of Boulton, Morales, and Hoffman discloses or suggests an inset image within the displayed electronic book. In response to Applicant's arguments, Boulton does disclose such feature (see fig. 8). Furthermore, Applicant argues that the examiner fails to make a prima facie case of obviousness since there is no suggestion or motivation to modify the references or combine reference teachings so as to arrive at the claimed invention. In response to applicant's arguments, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where



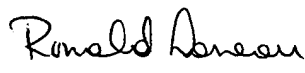
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there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Ronald Laneau  
Primary Examiner  
Art Unit 3714

11/15/06